

REMARKS

1. The application was filed with 18 claims, all of which are still pending. Claims 19 and 20 have been added. The Examiner has rejected Claims 1-18 under 35 U.S.C. § 102(a) as anticipated by U.S. Pat. No. 5,864,871 to Eduard Kitain et al. ("Kitain"). The rejection states that Kitain teaches a method for developing a dossier, and the rejection cites passages in Kitain for each step of method Claims 1-6. The rejection then states Claims 7-18 are similar to Claims 1-6 and rejects Claims 7-18 under the same rationale.

2. Applicants traverse the rejections. The claimed invention is for a method of developing a dossier. The first step of the method claimed in Claim 1 is for receiving the name of a client "relevant to a proposal." The application describes and claims an invention that is related to gathering information on a client and an industry that is "relevant to a proposal," i.e., a business proposal, plan, or idea. Kitain is directed to a computer-based corporate information delivery system, with emphasis on financial information and "research reports produced by and received electronically from brokerage firms." See Abstract.

Claim 1

Step (b) of amended Claim 1 is "presenting a list consisting of industries associated with the client." Support for the amendment is found at least in the claims as filed, the specification at pp. 36-38, and Figs. 20-23.

The rejection cites Kitain, col. 39, line 40 to col. 40, line 19, and Fig. 3, as disclosing this step. The passage states that the display lists "industries that the user may choose as selection criteria for documents, instead of contributors," such as industry groups. Col. 39, lines 41-43, and col. 40, lines 14-19. This passage does not describe or suggest that a list "consisting of industries associated with the client," but rather simply states that the user may select industries or industry groups. Kitain is silent as to whether or not the industries may be associated with a specific company. Indeed, Kitain teaches away from this step by teaching the listing of "all industries," which necessarily includes those not associated with the client, even before the name of a company is received. Therefore, this passage does not disclose step (b) of Claim 1.

At least this step of the method of Claim 1 is not disclosed by the reference. Nevertheless, Claim 1 has been amended in a non-narrowing fashion to make it clear that the list of industries in step (b) consists of only those industries associated with the client. A "list consisting of industries associated with the client" is not narrower than a "list of industries associated with the client," since both lists can only include industries with which the client is associated. The word "comprising" in a method claim opens the method claim to the inclusion of additional steps, but does not affect the scope of the structure recited within the steps. *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 48 U.S.P.Q. 2d 1161, 1167 (Fed. Cir. 1998) (affirming the district court's claim construction); *see also Moleculon Research Corp. v. CBS Inc.*, 229 U.S.P.Q. 805, 812 (Fed. Cir. 1986) (reversing a district court on claim construction because of impermissible broadening of structure recited within a step of a method).

Step (b) claims a step of presenting a list, and this non-narrowing amendment simply clarifies that the list is restricted to those industries associated with the client. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 1.

Claims 2-6

Amended Claim 2 further comprises "the step of presenting an alternate list consisting of industries not associated with the client." Claim 2 has been amended in a non-narrowing manner to more clearly express this step, that the alternate list of industries does not include industries that are associated with the client, since that list was already presented in step (b) of Claim 1. Support for the amendment is found at least in the claims as filed, the specification at pp. 36-38, and Figs. 20-23. As discussed above for Claim 1, the list of industries not associated with the client is limited to industries meeting this requirement. The addition of the word "consisting" does not alter the structure of this element, because any broadening beyond this definition is impermissible.

Claim 2 is rejected as over Kitain as disclosed by Fig. 3 and a passage from col. 40, lines 14-19. The passage discusses how a user can select industry groups, but does not describe or suggest "an alternate list of industries" (emphasis added) as claimed. Step (b) of Claim 1 requires "presenting a list consisting of industries associated with the client." As discussed above, Kitain does not describe or suggest this limitation, nor does Kitain

take the method a step further and present an "alternate list of industries," as required by Claim 2. Kitain does not describe or suggest the limitations of Claim 2.

Claim 4 has been rejected over Kitain, the rejection stating that Kitain teaches that the dossier is arranged in sections according to people, documents and projects, citing Fig. 7. Fig. 7 and the accompanying text describe newly-arrived documents in the search. There is no mention of arranging the contents of the dossier according to people, documents, or projects. Therefore, Kitain does not anticipate the limitations of Claim 4.

Claim 5 has been rejected over Kitain, the rejection stating that Kitain teaches that the "people section is arranged according to the number of documents and projects an individual has produced related to the client and industry," citing Fig. 7. However, Kitain contains no description or suggestion of the number of documents or projects an individual has produced related to a client or an industry. Therefore, Kitain does not anticipate the limitations of Claim 5.

As discussed above for Claims 1, 2, 4 and 5, the reference does not describe or suggest at least one limitation of each claim. Claims 2-6 are allowable because dependent claims are allowable if the independent claim from which they depend is allowable. The Examiner is respectfully requested to withdraw the rejection of Claims 1-6.

Claims 7-18

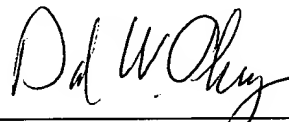
Claims 7-12 are similar to the above-discussed claims, but these claims claim a computer program embodied on a computer readable medium for developing a dossier. The arguments against the rejections are very similar to the arguments given above for the method Claims 1-6. Claims 13-18 are also similar, and are drawn to a system of logic for developing a dossier. The arguments against these rejections are also similar to the arguments given above for Claims 1-6.

Since Kitain does not describe or suggest at least one limitation for independent Claims 7 and 13, the rejections are overcome and the Examiner is respectfully requested to withdraw the rejection of Claims 7-12 and 13-18. Claims 7, 8, 13 and 14 have been amended in a non-narrowing manner to conform to the amendments made above to Claims 1 and 2. Support for the amendment is found at least in the claims as filed, the specification at pp. 36-38, and Figs. 20-23.

3. Applicants have amended the title to better describe the invention, and for no reason related to patentability. Applicants have amended claims in a non-narrowing fashion to better describe the claimed invention. In addition, Claim 3 has been amended to correct antecedent basis. New Claims 19 and 20 have been added. No new matter has been added in adding these two claims, for which support is found at least in the specification at pp. 37-38, and Figs. 24-27.

Applicants respectfully request the Examiner to enter the amendment, to reconsider the application, to withdraw the rejections and to grant early allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,



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